

Remarks

Claims 1-38 are pending in the application. By this paper, Applicants have canceled claim 29 and amended claims 7, 35, 36, and 37. Applicants believe that all claims are allowable and present remarks below to this effect. Accordingly, Applicants respectfully request careful reconsideration of the pending claims.

Claim Objections

Per the Examiner's suggestion, Applicants have amended claim 7 to fix the informality such that the claim language is in line with the other claims.

The Examiner objects to claim 22 due to a lack of antecedent basis and "confusing claim language." Applicants respectfully submit, however, that this objection is improper. Regarding the lack of antecedent basis objection, no specific indication as to which claim element supposedly lacks antecedent basis could be located in the Office Action. Furthermore, Applicants believe all the elements of claim 22 do have proper antecedent basis.

Regarding the "confusing claim language" objection, Applicants respectfully believe that the claim language of claim 22 is fully supported by the specification. In that regard, Applicants would like to direct the Examiner's attention to page 13 of the specification, lines 1-10, for example. Accordingly, Applicants respectfully request that the objection of claim 22 be withdrawn.

Obviousness Rejection

Claims 1-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,650,604 (hereinafter "*Marcous*") in view of Applicants' specification, pages 1-2 and 12 (hereinafter "*Disclosed Prior Art*"). Applicants respectfully traverse this rejection.

MPEP § 2143 details the basic requirements necessary to establish a prima facie case of obviousness:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations.

Claim 1, which is directed to a method for performing a money transfer *receive* transaction involving a desired amount of money to be transferred from a sender to a recipient, includes the steps of:

- receiving transaction identifying information provided by the recipient;
- comparing the transaction identifying information with transaction data stored on a host computer system;
- providing a confirmation code, to be issued to the recipient, if the transaction identifying information matches the transaction data stored on the host computer system;
- storing the confirmation code on the host computer system;
- receiving at the host computer system input corresponding to the confirmation code from a dispensing terminal in communication with the host computer system;
- comparing the input to the confirmation code stored on the host computer system; and
- allowing funds, corresponding to at least a portion of the desired amount of money, to be dispensed by the dispensing terminal if the input matches the confirmation code stored on the host computer system.

Marcous is directed to a system for facilitating electronic fund transfers involving a security code provided by a sender during an initiating transaction and entered by a recipient during a dispensing transaction. The dispensing or “money transfer receive”

transaction in *Marcous* is executed by: (1) receiving information from a recipient at a dispensing terminal (col. 8, ll. 53-67); (2) comparing the information entered by the recipient with information provided by a sender and stored in the system during an initiating transaction (col. 9, ll. 24-29); and (3) dispensing funds to the recipient if the information provided by the recipient matches (col. 9, ll. 39-56). The information entered into the system by the recipient includes the principal amount to be dispensed, the security code of the sender, and a system generated PIN issued to the sender. These items of information are communicated by the sender to the recipient (col. 4, ll. 16-21; col. 7, ll. 58-62; col. 8, ll. 58-65).

Contrary to the Examiner's contention, neither *Marcous* nor *Disclosed Prior Art*, either alone or in combination, teach or suggest "providing a confirmation code, to be issued to the recipient, if the transaction identifying information matches the transaction data stored on the host computer system." (Emphasis added.) Keep in mind the transaction identifying information to be matched is "provided by the recipient." Rather, *Marcous* merely teaches that if "there is a match between the information provided by the recipient and that listed within suspended journal files," the dispensing terminal receives "authorization approval" and is directed "to begin the process of dispensing the designated amount of funds." (col. 9, ll. 39-46.) Accordingly, *Marcous* fails to teach or suggest all of the claim limitations of claim 1 of the present application. Moreover, *Disclosed Prior Art* fails to cure the deficiencies of *Marcous*. Thus, Applicants respectfully believe that the §103(a) rejection of claim 1 and the associated dependent claims is improper and should be withdrawn.

It should be noted that many dependent claims of claim 1 recite additional features that are not disclosed in the cited references, taken alone or in combination. For example, claim 10 recites "providing an identification code to the recipient if the transaction identifying information matches the transaction data stored on the host computer system." (Emphasis added.) Neither *Marcous* nor *Disclosed Prior Art* teach or suggest this claim step. Rather, *Marcous* merely discloses "dispensing the designated amount of funds," not an identification code, to a recipient if "there is a match between the information provided by the

recipient and that listed within suspended journal files.” (col. 9, ll. 39-46.) Nor does *Disclosed Prior Art* cure the deficiencies of *Marcous*.

As another example, claim 28 recites the additional step of “receiving at the host computer system an identification code from an electronic terminal that is different from the dispensing terminal, the identification code being an anatomical image of the recipient.” Contrary to the Examiner’s contention, modifying *Marcous* and/or *Disclosed Prior Art* to include the above step would destroy the intended purpose or function of the references. In that regard, the only electronic terminal differing from the dispensing terminal in the disclosures of both *Marcous* and *Disclosed Prior Art* can be found in reference to the *send* transaction. *Marcous* discloses an “initiating terminal,” which “is the medium the sender uses to create the request to electronically transfer money.” (col. 4, ll. 41-52.) Similarly, *Disclosed Prior Art* discloses a “point of sale terminal” for “performing send transactions” where an agent enters information provided by the sender. (p. 1, ll. 17-23.) In order for the host computer system to receive an anatomical image of the recipient from an electronic terminal associated with the send transaction, the recipient would need to be present. Were the recipient present during the send transaction, the electronic money transfers disclosed in *Marcous* and *Disclosed Prior Art* would be unavailing and dispensable. Hence, Applicants respectfully believe that the Examiner’s proposed modification would not have been obvious to one of ordinary skill in the art.

As yet another example, claim 35 recites the additional limitation “wherein the confirmation code is not provided by the sender.” Please note that Applicants have amended claim 35 for purposes of clarity. Recall that *Marcous* is directed to a system for facilitating electronic fund transfers involving a security code and PIN *provided by a sender* to a recipient during an initiating transaction, and then entered by a recipient during a dispensing transaction. Once the recipient is given both the security code and the PIN *by a sender*, the dispensing or “money transfer receive” transaction in *Marcous* is executed by: (1) the recipient inputting the security code, PIN, and amount to be dispensed at a dispensing terminal (col. 8, ll. 52-67); (2) comparing the information entered by the recipient with information provided by the sender

and stored in the system during an initiating transaction (col. 9, ll. 24-29); and (3) dispensing funds to the recipient if the information provided by the recipient matches the information stored in the system (col. 9, ll. 39-56). Again, the information entered into the system by the recipient includes the principal amount to be dispensed, the security code of the sender, and a system generated PIN issued to the sender. These items of information *must be communicated by the sender* to the recipient (col. 4, ll. 12-21; col. 7, ll. 58-62, col. 8, ll. 58-65).

Marcous discloses that once the amount to be dispensed, the security code of the sender, and the system generated PIN issued to the sender (transaction identifying information) are inputted by the recipient during the dispensing transaction, and matched with the transaction data stored on the system, funds are dispensed to the recipient and the transaction is “completed.” (col. 9, ll. 39-56.) No additional “codes” are provided to the recipient. Thus, *Marcous* suggests that all information needed by the recipient to dispense funds is provided by the sender, indeed it “must be communicated by the sender to the recipient.” (col. 4, ll. 11-15.) Therefore, it is respectfully believed that it would not have been obvious to one of ordinary skill in the art to provide the recipient with “codes” for access to transferred funds that were not provided by the sender, because *Marcous* explicitly and repeatedly states that this information must be provided to the recipient by the sender. Moreover, it is respectfully believed that it would not have been obvious to provide additional “codes” to the recipient that are not provided by the sender, since the transaction, according to *Marcous*, is complete once the information provided by the sender to the recipient is matched (following input of the information by the recipient) and funds are dispensed. If anything, *Marcous* teaches away from the proposed limitation of claim 35. Thus, the §103(a) rejection of claim 35 is believed to be improper and should be withdrawn.

As still yet another example, dependent claim 36 recites the additional step of “receiving transaction identifying information, provided by the recipient, from a receive-transaction initiating terminal that is different than the dispensing terminal.” (Emphasis added.) It should be noted that Applicants have amended claim 36 for purposes of clarity to

emphasize that the transaction identifying information is *provided by the recipient*, though the base claim, claim 1, already makes this clear. Nevertheless, Applicants respectfully submit that neither *Marcous* nor *Disclosed Prior Art*, either alone or in combination, teach or suggest this additional claim step. Rather, *Marcous* teaches that the dispensing transaction is carried out when “[t]he recipient . . . goes to an ATM . . . [and] inputs the information as requested by the ATM screens and the cash is dispensed to the intended recipient.” (col. 4, ll. 16-29.) Thus, the *dispensing* transaction disclosed in *Marcous* does not contemplate “receiving transaction identifying information, provided by the recipient, from a receive-transaction initiating terminal that is different than the dispensing terminal.” (Emphasis added.) Likewise, *Disclosed Prior Art* fails to disclose this limitation. *Disclosed Prior Art* merely teaches that a recipient provides an MTCN or other information (transaction identifying information) to an agent that accesses a database using a terminal (receive-transaction initiating terminal). If the MTCN provided by the recipient corresponds to the MTCN stored in the database, then the agent issues funds (cash or check) on-site, *i.e.*, from the *same* terminal. (p. 2, line 21 - p. 3, line 4.) Thus, the *receive* transaction disclosed in *Disclosed Prior Art* does not contemplate “receiving transaction identifying information, provided by the recipient, from a receive-transaction initiating terminal that is different than the dispensing terminal.” (Emphasis added.) Furthermore, in both *Marcous* and *Disclosed Prior Art*, the terminal that differs from the “dispensing terminal” is a *send*-transaction initiating terminal and receives transaction identifying information *provided by the sender*, not the recipient.

With regard to independent claim 20, that claim recites “providing, by the host computer system, an *identification number and a confirmation code* to the receive-transaction initiating terminal, for issuance to the recipient, *if* the transaction identifying information matches the transaction data stored on the host computer system.” (Emphasis added.) Neither *Marcous* nor *Disclosed Prior Art*, either alone or in combination, teach or suggest this combination of features.

As noted above, *Marcous* merely discloses dispensing funds to a recipient, not an identification number and a confirmation code, if the transaction identifying information

matches the transaction data. (col. 9, ll. 39-46.) Moreover, *Disclosed Prior Art* merely recites that an agent can obtain a receive amount corresponding to the MTCN. (p. 2, ll. 25-26.) Whether the receive amount amounts to “information” as the Examiner suggests is irrelevant because claim 20 recites providing “an identification number and a confirmation code.” Accordingly, Applicants respectfully request that the rejection of claim 20, and its associated dependent claims, be withdrawn.

It should be noted that many dependent claims of claim 20 recite additional features that are not disclosed in the cited references, taken alone or in combination. For example, claim 37 recites the additional limitation “wherein the identification number and the confirmation code are not provided by the sender.” As another example, claim 38 recites the additional limitation “wherein the receive-transaction initiating terminal is different than the dispensing terminal.”

In view of the foregoing, Applicants respectfully request that the Examiner withdraw the obviousness rejection and pass these claims through to allowance.

Non-Statutory Double Patenting Rejection

The Examiner has also rejected claims 1-38 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of co-pending application no. 09/975,171 (U.S. Patent Application Publication 2003/0069856). Applicants will consider filing a terminal disclaimer upon an indication of otherwise allowable subject matter.

CONCLUSION

Applicants thank the Examiner for his time and effort in reviewing the present application. Applicants have made a genuine effort to respond to each of the Examiner's rejections in advancing the prosecution of this case. Applicants believe that all formal and substantive requirements for patentability have been met and that this case is in condition for allowance, which action is respectfully requested. Moreover, the Examiner is invited to contact the undersigned if any questions arise or any additional issues need to be resolved concerning the present application.

Respectfully submitted,
DEAN A. SEIFERT ET AL.

By 
Michael D. Cushion
Reg. No. 55,094
Agent for Applicant

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BROOKS KUSHMAN P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075-1238
Phone: 248-358-4400
Fax: 248-358-3351